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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/809,573	03/25/2004	Alexander S. Murison	11108.01	7132

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MICHAEL CHAN
NCR CORPORATION
1700 SOUTH PATTERSON BLVD
DAYTON, OH 45479-0001

EXAMINER

ST CYR, DANIEL

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 08/24/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/809,573

Applicant(s)

MURISON, ALEXANDER S.

Examiner

Daniel St.Cyr

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 25 March 2005.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 March 2005 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 8/04, 2/05.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

1. Receipt is acknowledged of the pre-amendment filed 3/25/04 in which claims 1-10 were canceled, claim 11 was amended, and claims 12-14 were added.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 11-14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-8 of U.S. Patent No. 6,739,503 (hereinafter '503 Patent). Although the conflicting claims are not identical, they are not patentably distinct from each other because the present claimed invention is somehow a broader recitation of the '503 patent. For instance in claim of the instant application and the '503 patent, the applicant claims:

i)"A method of processing a financial instrument at a self-service terminal having an endorser in an endorsing zone of the self-service terminal, the method comprising the steps of:

moving a door from an open position to a closed position to cover an opening through which a printhead of the endorser can move to print an endorsement onto the financial instrument so as to prevent the financial instrument from jamming into the printhead when the financial instrument is being transported into the endorsing zone of the self-service terminal;

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transporting the financial instrument to the endorsing zone of the self-service terminal;
and

moving the door from the closed position back to the open position to uncover the opening to allow the printhead of the endorser to move through the opening to print an endorsement onto the financial instrument when the financial instrument is in the endorsing zone.”, wherein in the ‘503 patent, the applicant claims:

ii)” A self-service terminal comprising: a fascia including means defining a document slot; and a document processing module including (i) means defining a document transport path, (ii) a document transport mechanism for transporting a document along the document transport path, (iii) an endorser including a printhead disposed along the document transport path and for printing an endorsement onto the document, and (iv) means for preventing the document from being jammed into the printhead as the document is being transported along the document transport path in the vicinity of the endorser; wherein the means for preventing the document from being jammed into the printhead comprises a door covering an opening and slidable between an open position in which the printhead is able to move through the opening to print an endorsement onto the document and a closed position in which the door prevents the document from being jammed into the printhead as the document is being transported along the document transport path in the vicinity of the printhead.”.

Thus, in respect to above discussions, it would have been obvious to an artisan at the time the invention was made to use the teaching of claims 1-8 of ‘503 patent as a general teaching for processing financial documents, to perform the same function as claimed in the present invention. The instant claims obviously encompass the claimed invention of the ‘503 patent and

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differ only in terminology. The extent that the instant claims are broaden and therefore generic to claimed invention of '503 patent [species], In re Goodman 29 USPQ 2d 2010 CAFC 1993, states that a generic claim cannot be issued without a terminal disclaimer, if a species claim has been previously been claimed in a co-pending application.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from the claims in a first patent. IN re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. & 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. & 1.78(d).

Allowable Subject Matter

4. Claims 11-14 would be allowable upon filing of a **terminal disclaimer**.

5. The following is a statement of reasons for the indication of allowable subject matter:

Although the prior art of record teaches systems for processing financial instruments which includes printing device for endorsing the instrument, the prior art fails to disclose or fairly suggest a moving member (i.e. a door) for moving in a first position to block the printing head to prevent jamming of the instruments during insertion and to a second position to allow the printing head to move toward the endorsement zone for endorsing the instruments. These limitations in conjunction with other limitations in the claims were not shown by the prior art of record.

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Kallin et al, US patent No. 5,274,567. Togashi et al, US Patent No. 6,412,995. Mochizuki et al, US patent no. 6,190,071. Momose, US patent No. 6,182,896.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel St.Cyr whose telephone number is 571-272-2407. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on 571-272-2398. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Daniel St.Cyr
Primary Examiner
Art Unit 2876

A handwritten signature in black ink, appearing to be 'Daniel St.Cyr', with a large, stylized loop at the end.

DS
August 22, 2005